

REMARKS

This is a Response to the Office Action dated September 8, 2004. Claims 1, 2, 4-7 and 25-32 are pending in this application. The Examiner has rejected Claims 1, 2, 4-7 and 25-32. As noted above, Applicants have amended Claims 1, 2 and 29-32. The amendments are supported by the written description.

Specification

The Examiner has objected to the Specification under 35 U.S.C. § 132. Applicants' response to this objection is provided in the following section.

The Examiner has also objected to the Specification regarding the history of the priority document. Applicants have amended the Specification to provide the patent number information.

New Matter under 35 U.S.C. § 132 and***Claim Rejections under 35 U.S.C. § 112***

The Examiner has objected to the Specification under 35 U.S.C. § 132 finding that the amendment filed on September 12, 2003 introduced new matter into the disclosure. The Examiner in particular has found that the following addition to the Specification is not supported by the original disclosure: "the pores have an open end and a closed end so as to provide a closed pore system on the surfaced of the member."

Moreover, Claims 1, 2, 4-7, 25 and 26 have been rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. The Examiner has found that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, possessed the claimed invention. In particular, the Examiner has found that the original specification "failed to teach or suggest a stent support member having pores 'wherein the pores have an open end and a closed end so as to provide a closed pore system on the surface of the member.'"

Under 35 U.S.C. § 132, “[n]o amendment shall introduce new matter into the disclosure of the invention.” Moreover, 35 U.S.C. § 112, first paragraph, requires the applicant to “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). An applicant can describe the invention “by such descriptive means as words, structures, figures, diagrams, formulas, etc.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). In fact, drawings alone “may provide a ‘written description’ of an invention as required by § 112.” *Vas-Cath*, 935 F.2d at 1565. However, to satisfy the written description requirement, “the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” *Crown Operations Int'l v. Krone*, 289 F.3d 1367, 1376 (Fed. Cir. 2002); see also, *Lockwood*, 107 F.3d at 1572. In other words, the specific words in the claims do not have to be present in the specification as filed to provide support for the claimed subject matter at issue.

Similarly, according to well-established patent law, “[b]y disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended [to] recite the function, theory or advantage without introducing prohibited new matter.” *In re Reynolds*, 443 F.2d 384, 398 (CCPA 1971) (quoting *Technicon Instruments Corp. v. Cole Instruments, Inc.* 255 F.Supp. 630 (N.D. Ill. 1966), *aff'd*, 385 F.2d 391 (7th Cir. 1967)).

Applicants respectfully submit that the application as filed conveyed with reasonable clarity to those skilled in the art that Applicants were in possession of the invention as of the filing date of the original disclosure and that the amendment filed on September 12, 2003 did not include “new matter.” First of all, the Specification as filed explicitly suggested that the pores can be either part of an “open pore system” or a “closed pore system.” For example, the

Specification broadly states in paragraph 28 on page 9 that “the particular material selected for coning end portions 30 and 36 can be any material having a plurality of pores 44 suitable to receive or absorb the coating substance deposited thereon during the coating process.”

Furthermore, although the Specification notes that in one of the embodiments, “[p]ores 44 can be interconnected,” the Specification does not explicitly or implicitly exclude a “closed pore system.” Instead, the Specification merely suggests that there might be advantages to using a member with an “open pore system.” In particular, in paragraph 28 on page 9, the Specification states, “[i]nterconnected pores 44 provide a network for moving and holding the coating substance, thus enabling coning end portions 30 and 36 to hold a larger amount of the coating substance than **coning end portions 30 and 36 having discrete pores 44, each with a fixed capacity for uptake of the substance.**” As shown by the bold and underlined text in the quoted sentence, Applicants clearly contemplated that the member could include “discrete pores,” i.e., pores of a “closed pore system.”

Moreover, the Specification implicitly or inherently described a member having a “closed pore system.” First, the Specification indicates that the porous surface can be made of substances that have “closed pore systems.” For instance, the Specification at least suggests that the porous substrate can be made of glass (see paragraph 29 on page 10), and glass has a “closed pore system” according to the enclosed extrinsic evidence. In the enclosed document entitled, “Application: Window and Perimeter Silicone,” “closed pore substrates” include “anodized aluminium, . . . glass and glazed surfaces.” Second, the Specification indicates that the surfaces having the pores can be made by methods that form “closed pore systems.” For example, the Specification in paragraph 30 on page 10 indicates that the surfaces “having pores 44 can be made, for example, . . . by sintering metallic particles together in a suitably-shaped mold.” The enclosed extrinsic evidence, entitled, “Solid State Sintering,” indicates that in the “final stage” of

a sintering process, there is a “change of pore shape from open pore to closed pore.” See page 17.

Finally, although the original Specification does not specifically indicate that the pores of the “closed pore system” have “an open end and a closed end,” the pores of a “closed pore system” would inherently have this structure, as explained in the Specification. For instance, according to the Specification in paragraph 28 of page 9, pores 44 of a closed pore system “are isolated from one another,” and the pores are discrete with each having “a fixed capacity for uptake of the substance.”

In short, the Specification as originally filed clearly had support for Claims 1, 2, 4-7, 25 and 26 and the amendment filed on September 12, 2003 did not include “new matter.” Applicants respectfully request the Examiner to reconsider the objection and rejection and allow the claims.

Double Patenting

Claims 1, 2, 4-7 and 25-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-17 of U.S. Patent No. 6,673,154. At this point neither the Examiner nor Applicants know the scope or content of the claims that will be found allowable from this application. Once that information is known, if the obviousness-type double patenting rejection is still appropriate, Applicants will promptly file a terminal disclaimer over U.S. Patent No. 6,673,154. Please hold this double patenting rejection in abeyance until then.

Claim Rejections - 35 U.S.C. § 102

A. Frisch – Claims 1, 4, 5 and 29-32

Claims 1, 4, 5 and 29-32 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Frisch (U.S. Patent Number 4,906,423). Frisch is related to methods for forming

"porous-surfaced polymeric bodies and particularly to such methods which use leachable foamed materials as the molding surface." Column 1, lines 6-9.

With regard to Claim 1, Frisch at least fails to disclose a member having a "closed pore system." Instead, Frisch discloses that the "foams may have various ratios of open cell to closed cells: however, the foam s [sic] surface needs some open cells in order for the polymeric composition to penetrate into the foam to form a porous-surfaced body." If the foamed material of Frisch contained a closed pore system, the foamed material could not be used for its intended purpose, namely, to act as an injection mold. In particular, if the foamed mold material of Frisch had a closed pore system, then the polymeric body embedded in the mold material would disintegrate during the step of leaching the foam material. This is because in a closed pore system, the polymeric composition would not be able to penetrate into the foam because each pore of the closed pore system is distinct (i.e., isolated from each of the other pores), and when the mold is leached in the Frisch process, the only thing remaining would be independent bits of polymer the size of the individual pores. Accordingly, Claim 1 should be allowable over Frisch. Claims 4 and 5 depend from Claim 1 and should be allowable for at least the same reason.

With regard to Claims 29 and 30, Applicants have amended these claims to depend on Claim 27. The Examiner has indicated that Claim 27 is allowable over the prior art (since it has only been rejected under obvious-type double patenting). Accordingly, Claims 29 and 30 should also be allowable over the prior art.

With regard to amended Claims 31 and 32, Frisch at least does not disclose a support assembly including "a first element to make contact with one side of a stent, and a second element to make contact with another side of the stent." Therefore, these claims are allowable over Frisch.

B. Parsons et al. – Claims 1, 4 and 5

Claims 1, 4 and 5 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Parsons et al. (U.S. Patent Number 6,521,284). Parsons et al. is directed to a process for impregnating a porous material with a cross-linkable composition. See Abstract. The porous substrate is impregnated while it is supported by a mandrel. See, e.g., column 4, lines 57-67.

With regard to the configuration of the mandrel, Parsons et al. describe two basic embodiments, neither of which disclose all of the limitations of amended Claim 1. In one embodiment, the mandrel includes openings, but the openings are not “capable of receiving a coating substance during a coating process.” In this first embodiment, Parsons et al. discloses, “the mandrel 2 may have openings 12 which are micropores that permit passage of gases but do not permit passage of other materials, such as the cross-linkable composition 14 used in the present invention.” Column 5, lines 15-19. In the other embodiment, the mandrel can have pores with a sufficient size to allow the passage of the cross-linkable composition. See column 5, lines 30-36.

However, in this second embodiment of Parsons et al., the pores of the mandrel would not “have an open end and a closed end so as to provide a closed pore system on the surface of the member.” For the second embodiment of Parsons et al., if the pores were part of a closed pore system, then the composition would not be released from the body of the mandrel to the outer surface of the mandrel so that it could impregnate the inner surface of the porous material. Accordingly, Claim 1 is allowable over Parsons et al. Claims 4 and 5 depend from Claim 1 and should be allowable as well.

Claim Rejections - 35 U.S.C. § 103**A. Frisch – Claims 2, 6 and 25**

Claims 2, 6 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Frisch. As noted above, Claim 1 is allowable over Frisch. Claims 2, 6 and 25 depend from Claim 1 and should be allowable as well.

B. Parsons et al. – Claims 2, 6, 7, 25 and 26

Claims 2, 6, 7, 25 and 26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Parsons et al. As noted above, Claim 1 is allowable over Parsons et al. Claims 2, 6, 7, 25 and 26 depend from Claim 1 and should be allowable as well.

CONCLUSION

Claims 1, 2, 4-7 and 25-32 are pending in this application. Examination and allowance of the claims are respectfully requested.

If the Examiner has any questions or needs any additional information, the Examiner is invited to telephone the undersigned attorney at (415) 954-0345.

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